REMARKS

In response to the final Office Action of March 18, 2009, the Advisory Action of July 22, 2009, and the Advisory Action of September 22, 2009, applicants request that all claims be allowed in view of the amendments to the claims and the following remarks. Claims 36, 48, 56, 64, 68, 69, and 82 are pending in the application, all of which are independent.

Request for Entry of Amendment

Applicants have amended independent claims 36, 48, 56, 64, 68, 69, and 82 to incorporate previously pending dependent claims 90-96, respectively. In addition, applicants have canceled all of the remaining dependent claims. Therefore, considering that previously pending dependent claims 90-96 depended from independent claims 36, 48, 56, 64, 68, 69, and 82, respectively, and that no claims now depend from any of independent claims 36, 48, 56, 64, 68, 69, and 82, applicants submit that the amendments to independent claims 36, 48, 56, 64, 68, 69, and 82 do not raise any new issues. Accordingly, applicants request entry of the amendments to the claims.

In applicants' Amendment filed on August 18, 2009, applicants amended independent claims 36, 48, 56, 64, 68, 69, and 82 in identical fashion to amendments being made to independent claims 36, 48, 56, 64, 68, 69, and 82 by way of the present Amendment. However, in applicants' Amendment of August 18, 2009, applicants did not cancel any of dependent claims 37-42, 44-47, 49, 50, 52-55, 57-62, 65, 66, 69-77, 79-81, and 83. Consequently, dependent claims remained depending from each of newly amended independent claims 36, 48, 56, 64, 68, 69, and 82. As a result, the Advisory Action of September 22, 2009, indicated that the amendments to the claims made in applicants' Amendment of August 18, 2009 were not entered because the amendments to the claims raised new issues that would require further consideration and/or search. In particular, the Advisory Action of September 22, 2009 indicated that:

> Further search and/or consideration would be necessitated by the change in scope of the dependent claims that were not previously dependent on [the limitations added to the independent claims].

Advisory Action of September 22, 2009 at Continuation Sheet, lines 1-2.

In view of the fact that applicants have now canceled all of the remaining dependent claims, applicants submit that the amendments to the claims made by way of the present Amendment do not raise new issues such as were raised by the amendments to the claims in applicants' Amendment of August 18, 2009. Accordingly, applicants request entry of the present amendments to the claims.

Claim Rejections Under 35 U.S.C. § 103

The final Office Action rejected dependent claims 90-96 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,212,548 (DeSimone), U.S. Patent No. 6,748,421 (Ozkan), U.S. Patent No. 7,233,992 (Muldoon), and U.S. Patent No. 6,795,863 (Doty). However, as discussed in applicants' June 17, 2009 Reply and applicants' August 18, 2009 Amendment, the combination of DeSimone, Ozkan, Muldoon, and Doty does not render previously pending dependent claims 90-96 obvious. Consequently, in hopes of advancing prosecution, applicants have canceled claims 90-96 and have amended each of independent claims 36, 48, 56, 64, 68, 69, and 82 to incorporate the features of previously pending dependent claims 90-96.

Accordingly, applicants request that prosecution be reopened in view of the amendments to independent claims 36, 48, 56, 64, 68, 69, and 82. Alternatively, in the event that prosecution is not reopened in view of the amendments to independent claims 36, 48, 56, 64, 68, 69, and 82, applicants have provided the remarks below in the hopes of eliciting a meaningful response to the amendments to the claims in order to clarify any unresolved issues for appeal.

As amended, independent claim 36 recites, among other features, determining if a recipient is capable of participating in video instant messaging in response to initiating a text instant messaging session between a sender and the recipient and enabling a graphical user interface displayed to the sender to reflect that the recipient is capable of participating in video instant messaging based on a determination that the recipient is capable of participating in video instant messaging.

The final Office Action acknowledges that DeSimone, Ozkan, and Muldoon fail to describe or suggest these features. Final Office Action of March 18, 2009 at page 16, lines 10-15. Therefore, the final Office Action relies on Doty for teaching these features.

Doty teaches a system that streams video to an e-mail recipient using a web-based e-mail application. *See e.g.*, Doty at Abstract. As described by Doty, Doty's system displays the video streamed to the e-mail recipient in the same web page through which the e-mail recipient sends and receives e-mails using the web-based e-mail application. *See e.g.*, Doty at Abstract and FIG. 4. As further described by Doty, before video is streamed to the e-mail recipient, Doty's system determines certain capabilities of the e-mail recipient's computer and then streams the video to the e-mail recipient in a format and at a bit-rate that are determined to be appropriate based upon the determined capabilities of the e-mail recipient's computer. *See, e.g.*, Doty at col. 8, line 45 to col. 9, line 4.

Notably, Doty describes that the video streamed to the e-mail recipient is produced and streamed to the e-mail recipient by an organization that is responsible for producing and streaming video to e-mail users, not by other users who have sent e-mails to the e-mail recipient. *See* Doty at col. 10, lines 33 to col. 12, line 43. Because Doty describes that the video streamed to the e-mail recipient is produced and streamed to the e-mail user by an organization that is independent from and unrelated to users who have sent e-mails to the e-mail recipient, Doty does not describe or suggest determining if the e-mail recipient is capable of participating in video messaging *in response to initiating a communications session between the e-mail recipient and an e-mail user who has or is going to send an e-mail to the e-mail recipient*. Furthermore, because Doty describes that the video streamed to the e-mail recipient is produced and streamed to the e-mail user by an organization that is independent from and unrelated to users who have sent e-mails to the e-mail recipient, it is not surprising that Doty does not describe or suggest indicating any of the e-mail recipient's capabilities, let alone the e-mail recipient's capability to engage in video messaging, to an e-mail user who has or is going to send an e-mail to the e-mail recipient.

Thus, even when Doty's teachings are combined with those of DeSimone, Ozkan, and Muldoon, the combination does not describe or suggest determining if a recipient is capable of participating in video instant messaging in response to initiating a text instant messaging session

between a sender and the recipient and enabling a graphical user interface displayed to the sender to reflect that the recipient is capable of participating in video instant messaging based on a determination that the recipient is capable of participating in video instant messaging, as recited in amended independent claim 36. Accordingly, for at least this reason, applicants request reconsideration and withdrawal of the rejection of independent claim 36.

Each of independent claims 48, 56, 64, 68, 69, and 82 has been amended to recite features that are similar to those recited in amended independent claim 36 and discussed above. Accordingly, applicants request reconsideration and withdrawal of the rejection of independent claims 48, 56, 64, 68, 69, and 82 for at least the reasons discussed above in connection with independent claim 36.

Conclusion

Applicants submit that all claims are in condition for allowance.

It is believed that all of the pending issues have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this reply should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this reply, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

No fees are believed due in connection with the filing of this Amendment. In the event that any charges or credits are due in connection with filing this Amendment or otherwise, please apply any such charges or credits to Deposit Account 06-1050.

Respectfully submitted,

Date: October 3, 2009

Andrew T. Foy
Reg. No. 57,333

Fish & Richardson P.C.
1425 K Street, N.W.
11th Floor
Washington, DC 20005-3500
Telephone: (202) 783-5070
Facsimile: (877) 769-7945

40598317.doc